REMARKS

Reconsideration and allowance of the captioned patent application are respectfully requested. The captioned patent application addresses indoles that have PPAR agonist activity which are useful for treating diabetes and related conditions.

The Examiner modified and maintained restriction of the application, alleging that four patentably distinct groups exist. Applicants previously elected group I with traverse. The Examiner deemed the restriction requirement final and withdrew claims 19 and 20 as drawn to a non-elected invention.

Applicants have cancelled claims 19 and 20 to expedite prosecution and amended the claims to delete the previously non-elected subject matter. Applicants reserve the right to file divisional applications to continue prosecution of all non-elected subject matter as appropriate.

Claims presently in the case are 1-17. All other claims have been cancelled. Claims 1, 3 and 5 have been amended. No new subject matter has been added.

The Examiner objected to claims 1-9, 17 and 29 as addressing non-elected subject matter, objected to 1-17 and 29 for depending from a rejected base claim and rejected claims 1, 3, 8-10, 17 and 29 under 35 USC § 112 paragraph 1 for inadequate written description and non-enablement.

As noted above, the claims have been amended to address the subject matter of group 1. Hence, the objection for containing non-elected subject matter has been overcome. Upon making a determination that claim 1 is allowable, the objections to claims 1-17 for depending from a rejected base claim will become moot. Claim 29 has been cancelled rendering the rejection of claim 29 moot as well. Applicants respectfully traverse the rejection under 35 USC § 112 paragraph 1.

There is no precise formulation that must be met to satisfy the written description requirement. The Applicant must merely advise those of ordinary skill what it is that he considers to be his invention, with sufficient precision so as to allow the reader to readily ascertain what it was that the inventor was in possession of at the time of filing.

Applicants have provided more than sufficient detail in this regard. Indole based molecules are described that are substituted at position 1 with an optionally substituted benzisoxazole (or other)

group, at position 2 with a short alkyl or halo alkyl group, and at position 3 with a variable in which X is a bond or is selected from a list of 7 linking moieties. Y is another linking moiety, Z represents an acid or a tetrazole and A_p represents H or up to 3 small alkyl, alkenyl, alkoxy or halo groups, or halo substituted versions thereof. Similarly, $(R^4)_q$ represents H atoms or up to 3 small groups as defined in claim 1.

The Applicants provided more than sufficient detail to describe these compounds, both generically and specifically. Over a hundred examples of compounds of formula I have been disclosed, as well as a description of the activity as PPAR agonists. Representative doses for treating type 2 diabetes and related conditions have been provided. This is more than sufficient detail to meet the written description requirement.

The Examiner has alleged that the variable Y-Z is broader then the support provided by the application. Applicants respectfully disagree. The 5 variables recited in the definition of Y taken in combination with the 2 variables represented by Z provide only 10 possible basic combinations (disregarding R^7 and R^8). Descriptions of numerous sub-groups are provided for Y and Z. See page 7, line 14, for example, where Y represents OCR^7R^8 or $CH_2R^5R^6$; page 8, line 11, where Y represents the same subset; page 9, line 12, where Y represents OCR^7R^8; line 15, where Y represents CH_2CHR^5; and line 35 where the carbon atom in Y when Y represents OCR^7R^8 is asymmetric. Z is even more explicitly addressed as either CO_2H or a tetrazolyl group. See page 5, line 14.

It is therefore urged that no further description is necessary to meet the written description requirement.

It is unclear why the Examiner has commented upon the structure/function or SAR of the presently claimed compounds. Applicants are not required to provide SAR information or data to meet the written description requirement under 35 U.S.C. § 112 paragraph 1. It is noted that Liu et al. is not prior art to the present application, and it is respectfully urged that the claims in their present form fully comply with the written description requirement.

The Examiner's rejection for non-enablement is also respectfully traversed. No undue experimentation would be required for one of ordinary skill to make and use a compound of formula I, taking into account the generic description and examples that are provided in the specification. Again, it appears that the Examiner is alleging that the application is non-enabling for compounds outside the

scope of formula I. This is not a proper analysis of the enablement requirement, since enablement is only required with respect to the claimed subject matter.

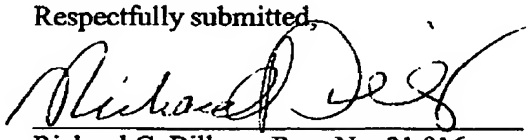
More than adequate detail has been provided for one of ordinary skill to be able to synthesize the compounds that are claimed, particularly taking into account the level of skill in the relevant field, the availability of commercial starting materials, and the art of record.

Applicants have also provided more than sufficient information regarding use for the treatment of diabetes, particularly type 2 diabetes, and related conditions. One of ordinary skill in the medical arts is clearly able to determine whether a particular patient is diabetic. Adequate detail has been provided with respect to dosing at pages 18-19, and with respect to preparation of pharmaceutical compositions on page 19.

One does not need to be able to predict activity and/or binding levels of a compound to the PPARγ receptor, to be able to make and use the compounds that are disclosed and claimed. Applicants have disclosed over 50 compounds that fall within the genus. Those compounds and others related to them that fall within claim 1 are fully enabled; and there is nothing about the genus of claim 1 that is not fully enabled by the specification.

Based upon the foregoing, reconsideration and allowance are respectfully requested. If the Examiner has any questions she is respectfully requested to telephone the undersigned.

Respectfully submitted,

By 

Richard C. Billups, Reg. No. 31,916
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel: (732)594-4683

Date: January 11, 2008